



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,346	04/09/2004	Craig A. Finseth	PD-990199A	1002
7590 03/05/2008				
Hughes Electronics Corporation Corporate Patents & Licensing RE/R11/A109 P.O. Box 956 El Segundo, CA 90245				
		EXAMINER PENG, FRED H		
		ART UNIT 2623		
		MAIL DATE 03/05/2008		
		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/821,346

Applicant(s)

FINSETH ET AL.

Examiner

Fred Peng

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/09/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 26 and 55-78 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 25 and 1-24 of prior U.S. Patent No. 6,754,906. This is a double patenting rejection.

Claims 26, 55-78 are identical claims as Claims 25, 1-24 of U.S. Patent No. 6,754,906 respectively.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-24, 27-30, 32-39, 41-53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,754,906. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-24 are anticipated by Claims 1-24 of U.S. Patent No. 6,754,906 respectively.

Claims 27-30 are anticipated by Claim 14 of U.S. Patent No. 6,754,906. Arranging different levels of categories are hierarchical arrangement.

Claims 32-35 are anticipated by Claims 16, 18-19 and 14 of U.S. Patent No. 6,754,906 respectively.

Claims 36-39 are anticipated by Claim 1 of U.S. Patent No. 6,754,906 as same analysis as for Claims 27-30.

Claims 41-53 are anticipated by Claims 3, 5-13, 18-19 and 1 of U.S. Patent No. 6,754,906 respectively.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 25, 27-28, 30-31, 33-37, 39-40, 42-44 and 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowe et al (US 5,623,613).

Regarding Claim 25, Rowe discloses an electronic program guide comprising:

a set of electronic program guide data including a plurality of program titles and a plurality of organizational categories, where each program title belongs to at least one organizational category (FIG.2);

a spatial arrangement of program titles in an outline format, where a first-level organization of the electronic program guide utilizes one organizational category and defines the first-level of the outline format (FIG.2, elements 52, 54; Sports column and Basketball column define first level of outline format), and a second-level organization of the electronic program guide utilizes a different organizational category; and defines the second-level of the outline format (FIG.2, elements 54, 56; Basketball column and related programs define second level of outline format); and

wherein the first organizational category and the second organizational category can be used at either of the first level of the outline format and the second level of the outline format (Both Sports column and Basketball column can acts as stand along first level or second level that includes corresponding programs).

Regarding Claims 27, 36 and 54, Rowe discloses an apparatus (FIG.1, element 32) with corresponding method and a program storage device (set-top converter inherently includes a program storage device) for providing a program guide to a display (FIG.2), comprising:

a memory for storing program guide data including a plurality of organizational categories; a plurality of program titles, each associated with at least one organizational category (Col 3 lines 22-38);

a processor (inherent in set-top converter), communicatively coupled to the memory, for generating data describing the program guide, wherein the program guide includes a hierarchical arrangement of at least a portion of the organizational categories (FIG.2; elements 52, 54, 56),

the hierarchical arrangement including a plurality of organizational levels, wherein the at least a portion of the organizational categories are used at any of the organizational levels (50, 52, 54; Sports column 52 can be used as both first level that includes 54 and used as second

level that included in schedule display 50, Basketball column 54 also can be used as first and second level); at least a subset of the program titles associated with the organizational category (56; display program titles are associated with selected Basketball category).

Regarding Claims 28 and 37, Rowe further discloses a graphical indicia of the association between the organizational category and the program titles associated with the organizational category, and wherein the graphical indicia is a spatial proximity between the program title and the organizational category (FIG.2, element 58; the frame indicates a spatial proximity between Basketball and NCAA game).

Regarding Claims 30 and 39, Rowe further discloses organizational categories [[including]] include a lowest level organizational category, and the graphical indicia indicates an association between the lowest level organizational category and the program titles associated with the lowest level organizational category (FIG.2, element 58; the frame is graphical indicia indicates an association between the lowest level organizational category and the program titles associated with the lowest level organizational category).

Regarding Claims 31 and 40, Rowe further discloses the hierarchical arrangement is user-controllable (FIG.2; user can select different category for display).

Regarding Claims 33-34, 42-43 and 51-52, Rowe further discloses means for receiving a user tuning request selecting a user-link; and means for responding to the user request by displaying program content associated with the selected user link (FIG.2; user selects a program from the guide and display the program).

Regarding Claims 35 and 53, Rowe further discloses the organizational categories include: a first level organizational category defining an overall content of the program guide

(FIG.2, element 52); and a second level organizational category defining a spatial separation of the program titles (element 54).

Regarding Claim 44, Rowe further discloses instructions to display additional program guide information selected from the group comprising: textural program guide data; and graphical program guide data (FIG.2, elements 96, 92).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 29 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al (US 5,623,613).

Regarding Claims 29 and 38, Rowe discloses program selection based on a time category (Col 1 lines 33-36) and topic category (FIG.2; Col 2 lines 33-41).

Rowe discloses topic category like sports but not specifically about an actor category.

The Official Notice is taken that it is well known in the art to search programs based an actor name.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an actor category as a popular alternative way for favorite program search.

9. Claims 32, 41, 45-48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al (US 5,623,613) in view of Knowles et al (US 2005/0251822).

Regarding Claims 32 and 41, Rowe is silent about the organizational categories are differentiated by color.

In an analogous art, Knowles discloses the organizational categories are differentiated by color (Para 157).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rowe's system to include color differentiation for categories to provide more user friendly interface.

Regarding Claims 45 and 46, Rowe is silent about displaying a receiver operating menu and comprising a second-link for providing instructions to display the program guide based on the organizational categories.

In an analogous art, Knowles discloses displaying a receiver operating menu and comprising a second-link for providing instructions to display the program guide based on the organizational categories (FIG.18, element 162).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rowe's system to include a receiver operating menu to provide more user friendly interface.

Regarding Claims 47-48 and 50, Rowe discloses signaling the receiver to display a specified program.

Rowe is silent about a specific program recording and reminder.

In an analogous art, Knowles discloses setting a specific program recording and reminder (FIG.30; FIG.31; FIG.32; Para 83 lines 1-4; Para 89 lines 1-3).



It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rowe's system to include a specific program recording and reminder to provide more user friendly interface.

10. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al (US 5,623,613) in view of Herz et al (US 5,835,087).

Regarding Claim 49, Rowe is silent about three-dimensional display of some program titles.

In an analogous art, Herz discloses grouping same category objects in a three-dimensional menu (Col 70 lines 53-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rowe's system to include a three-dimensional display menu as taught by Herz to provide more user information.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Peng whose telephone number is (571) 270-1147. The examiner can normally be reached on Monday-Friday 09:00-18:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/821,346  
Art Unit: 2623

Page 9

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred Peng  
Patent Examiner

Vivek Srivastava  
Supervisory Patent Examiner

A handwritten signature in black ink, appearing to read 'Vivek Srivastava', with a long horizontal flourish extending to the right.

VIVEK SRIVASTAVA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600